

RECEIVED
CENTRAL FAX CENTER

JAN 22 2007

REMARKS

The Office Action dated October 18, 2006 contained a rejection of claims 1-2 and 4-24. The Applicant has amended independent claims 1, 15 and 24. Claims 1-2 and 4-24 are in the case. Reexamination and reconsideration of the application, as amended, are requested.

The Office Action rejected claims 1, 2, and 4-24 under 35 U.S.C. § 103(a) as being unpatentable over Hattori (U.S. Patent No. 6,094,674) and Scholl et al. (U.S. Patent No. 5,742,762).

The Applicant respectfully traverses this rejection based on the amendments to the claims and the arguments below.

The Applicant's claimed invention now includes that the new member is queried by existing members and queries the existing members for existing web content names and associated URLs. Also, the reciprocal monitoring relationships are established with the members so that each member can monitor changes in the web content of the other members. Support for these new features can be found at least in paragraph [0011] of the Applicant's published U.S. Patent Application (U.S. Patent Publication No. 20020138615).

The Examiner argued on page 4 of the October 18, 2006 Office Action that Scholl et al. disclose the Applicant's claimed automatically allowing at least one new member to join the confederacy if the new member indicates that it has embedded content or other resources of interest to existing members of the confederacy and cited to col. 10, lines 1-25 of Scholl et al.

However, in light of the amendments to the claims, the Applicant submits that the combined references do not disclose, teach or suggest these newly added features. For example, Hattori in combination with Scholl et al. merely disclose adding "new systems by new manufacturers, say, NT&T, at a later date." (see col. 10, lines 1-25 of Scholl), but do not disclose the new member being queried by existing members and the new member querying the existing members for existing web content names and associated URLs and allowing the new members to establish reciprocal monitoring

relationships with the other members so that each can monitor changes in the web content of the other members, like the Applicant's claimed invention.

This **failure** of the combined cited references to disclose, suggest or provide motivation for the Applicant's claimed invention indicates a lack of a *prima facie* case of obviousness. W.L. Gore & Assocs. V. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983). In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Accordingly, the combined cited references cannot render the Applicant's invention obvious.

Further, even though the combined references do not disclose, teach, or suggest the Applicant's claimed invention, the references should not be considered together because Scholl et al. teach away from the Applicant's invention. MPEP section 2143.01, part V. clearly states that "[I]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Also, MPEP section 2143.01, part VI. states that "[I]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

Specifically, Scholl et al. explicitly disclose that "...the embodiment could be modified to add new systems by new manufacturers, say, NT&T, at a later date." (see col. 10, lines 1-25 of Scholl et al.). Consequently, Scholl et al. teach away because although Scholl can add new systems, the new systems are competing manufacturers. As such, unlike the Applicant's claimed invention, the competing manufactures in Scholl would not query each for existing web content names and associated URLs and also would not establish reciprocal monitoring relationships between each other to allow each competing manufacture to monitor changes in the web content of the other manufacturers. This is because the new members being added in Scholl et al. are new manufacturers for the phone system in Scholl et al., which compete directly with the other existing members. As such, the proposed modification or combination would render Scholl et al. being modified unsatisfactory for its intended purpose and would change the principle of operation of the

invention in Scholl et al. being modified if competing manufacturers were allowed to openly query each other and establish reciprocal monitoring relationships between each other for monitoring purposes in a non-competitive manner.

Therefore, this "teaching away" prevents this reference from being used by the Examiner. ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). Thus, since the Applicant's claimed elements of the new member being queried by existing members and querying the existing members for existing web content names and associated URLs and establishing reciprocal monitoring relationships with the members so that each member can monitor changes in the web content of the other members are not disclosed, taught or suggested by the Hattori in combination with Scholl et al., and because Scholl et al. teach away from the Applicant's invention, Scholl et al. cannot be used as a reference alone in combination with other references, and hence, the Applicant submits that the rejection should be withdrawn.

MPEP 2143.

In addition, the Examiner is reminded that these references should not be considered together with the benefit of hindsight. It is well-settled in the law that improper hindsight occurs when knowledge and advantages from the Applicant's disclosure is used or words or phrases are arbitrarily picked and chosen from references to recreate the Applicant's invention. Crown Operations International, Ltd. v. Solutia, Inc., 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002). In particular, the combination of elements in a manner that reconstructs the Applicant's invention only with the benefit of hindsight is insufficient to present a *prima facie* case of obviousness. Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986).

Even if the references in question seem relatively similar "...**the opportunity to judge by hindsight is particularly tempting**. Hence, the tests of whether to combine references need to be applied rigorously," especially when the Examiner uses a reference that does not explicitly disclose the exact elements of the invention or **teaches away** from the Applicant's claimed invention, which is the case here. McGinley v. Franklin Sports Inc., 60 USPQ 2d 1001, 1008 (Fed. Cir. 2001). Since hindsight cannot be used to support the rejections, the combined cited references cannot render the Applicant's invention obvious and the rejection is improper and should be withdrawn. Bausch & Lomb, Inc. v.

Barnes-Hind/Hydrocurve, Inc. Accordingly, this failure of the cited references to disclose, suggest or provide motivation for the Applicant's claimed invention indicates a lack of a prima facie case of obviousness (MPEP 2143).

With regard to the dependent claims, since they depend from the above-argued respective independent claims, they are therefore patentable on at least the same basis. (MPEP § 2143.03).

In view of the arguments and amendments set forth above, the Applicant respectfully submits that the rejected claims are in immediate condition for allowance. The Examiner is therefore respectfully requested to withdraw the outstanding claim rejections and to pass this application to issue. Additionally, in an effort to expedite and further the prosecution of the subject application, the Applicant kindly invites the Examiner to telephone the Applicant's attorney at (818) 885-1575. Please note that all correspondence should continue to be directed to:

Hewlett Packard Company
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

Respectfully submitted,
Dated: January 22, 2007



Edmond A. DeFrank
Reg. No. 37,814
Attorney for Applicant
(818) 885-1575 TEL
(818) 885-5750 FAX